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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,704

04/05/2007

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,704	<b>Applicant(s)</b> MARCON, LIONEL	
	<b>Examiner</b> Clark F. Dexter	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11,12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,16-18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 5,6,11,12,14,15,19 and 23-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2009 has been entered.

### ***Drawings***

2. The drawings were received on February 25, 2009. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 16-18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonito et al., pn 2,968,096 alone or alternatively, in view of one or both of McMurtrie pn 560,524 and Bradley, pn 3,543,616.

**Regarding claims 1 and 4**, Bonito discloses a device with almost every structural limitation of the claimed invention (with the lacking structure being indicated by strikethrough and grayed-out) including:

a first lever (e.g., 2) and a second lever (e.g., 12) articulated together on a pivot axis (e.g., at 10) for pivoting between an open position for receiving a tube which is to be cut and a closed position after cutting of the tube, wherein

the second lever includes a blade (e.g., 19),

the first lever includes

a rotatable shaft (e.g., 3) ~~parallel to the pivot axis of the first second levers,~~

and

a wheel (e.g., 6) rotatably mounted on rotary shaft and having a periphery, the periphery including a plurality of grooves (e.g., see col. 2, lines 37-39) having respective, different widths for receiving tubes of different diameters so that a groove selected according to the diameter of a tube to be cut can be placed opposite the blade when the wheel is turned to a corresponding position, wherein each of the grooves has a respective central axis transverse to the wheel ~~and substantially parallel to the pivot axis of the first and second levers;~~

[claim 4] wherein the wheel includes two disks that are parallel to one another, mounted coaxially on the rotary shaft, and spaced from one another on the rotary shaft (e.g., it can be argued that there are a plurality of integral disks disclosed, and outer disks are spaced from one another by inner disks).

**Regarding claim 16**, Bonito discloses a device with almost every structural limitation of the claimed invention (with the lacking structure being indicated by strikethrough and grayed-out) including:

a first lever (e.g., 2) and a second lever (e.g., 12) articulated together on a pivot axis (e.g., at 10) for pivoting between an open position for receiving a tube which is to be cut and a closed position after cutting of the tube, wherein

the second lever includes a blade (e.g., 19),

the first lever includes

a rotary shaft (e.g., 3), and

a substantially planar wheel (e.g., 6, which is “planar” is at least the same manner as the wheel 4, 44, 45 of the present invention) rotatably mounted on the rotary shaft and having a periphery, the periphery including a plurality of grooves (e.g., see col. 2, lines 37-39) having respective, different widths for receiving tubes of different diameters so that a groove selected according to the diameter of a tube to be cut can be placed opposite the blade when the wheel is turned to a corresponding position, wherein each of the grooves has a respective central axis transverse to the substantially planar wheel ~~and substantially parallel to the pivot axis of the first and second levers.~~

**Regarding claim 20**, Bonito discloses a device with almost every structural limitation of the claimed invention (with the lacking structure being indicated by strikethrough and grayed-out) including:

a first lever (e.g., 2) and a second (e.g., 12) lever articulated together on a pivot axis (e.g., at 10) for pivoting between an open position for receiving a tube which is to be cut and a closed position after cutting of the tube, wherein

the second lever includes a blade (e.g., 19),

the first lever includes

a rotary shaft (e.g., 3), and two substantially planar disks (e.g., it can be argued that there are a plurality of integral disks disclosed) rotatably and coaxially mounted on the rotary shaft ~~and spaced from each other~~, each disk having a periphery, the periphery of each disk including a plurality of grooves having respective, different widths for receiving tubes of different diameters so that a groove selected according to the diameter of a tube to be cut can be placed opposite the blade when the disks are turned to a corresponding position, wherein each of the grooves in each of the disks has a respective central axis transverse to the two substantially planar disks ~~and substantially parallel to the pivot axis of the first and second levers.~~

Regarding claims 1, 16, 18, 20 and 22, Bonito lacks the rotatable shaft being parallel to the pivot axis of the first and second levers. However, as stated in the previous Office action, to orient the shaft, and thus both shafts, of the pliers such that they are parallel to the pivot axis would have been the mere discovery of the optimum or workable ranges of shaft orientations within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art. If evidence of such a well known configuration is determined to be necessary, McMurtrie

and Bradley are just two examples of patents that teach or suggest such a parallel shaft orientation.

Regarding claims 2, 17 and 21, Bonito discloses a pliers with almost every structural limitation of the claimed invention but lacks a blade having two adjoining cutting edges intersecting at an outwardly projecting point as claimed. However, the Examiner takes Official notice that such blades are old and well known in the art and provide various well known benefits including making available a fresh cutting edge after one adjacent thereto becomes worn or damaged. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a blade on the pliers of Bonito to gain the well known benefits including that described above.

Regarding claim 4, in the alternative, if it is argued that Bonito does not sufficiently teach or suggest the specific claimed disk configuration, it would have been obvious to one having ordinary skill in the art to construct the plurality of integral rings such that they are separate disks to gain well known benefits including facilitating replacing the rings or changing out the rings for different sizes.

Further regarding claim 20, Bonito lacks the two substantially planar disks (e.g., it can be argued that there are a plurality of integral disks disclosed) with a plurality of grooves being spaced from each other. However, to simply provide additional grooves (and thus provide a plurality of grooved portions separated by a portion having at least one groove) by either elongating the shafts and roller or by providing more grooves in the existing roller configuration would have been obvious to one having ordinary skill in

the art for various well known reasons, particularly to facilitate cutting a larger range or a larger number of wire diameters.

***Allowable Subject Matter***

5. Claims 5, 6, 11, 12, 14, 15, 19 and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed February 25, 2009 have been fully considered but they are not persuasive.

Regarding applicant's request for interview, this Office action is being made non-final, and thus applicant has the opportunity and is welcome to contact the Examiner to discuss any outstanding issues.

Regarding applicant's amendments to correct informalities, applicant's efforts are appreciated and the drawings and specification are acceptable for examination.

In the paragraph bridging pages 12-13 of the subject response, applicant states the following:

*"Applicant respectfully notes that there was no objection to or rejection of claims 5, 6, 11, 12, 14, and 15, other than based on the formality rejection of claim 1. However, there was no indication of allowability of those claims. Thus, it appears that the Office Action may have not been complete as required by 37 CFR 1.104(a). If there are further formality rejections of claims, Applicant*



*respectfully requests an indication of whether the claim, independent of the formality rejection, is allowable or rejected over prior art."*

The Examiner respectfully directs applicant's attention to paragraph 12 at the top of page 12 of the previous Office action which indicates the allowability of the subject claims as well as canceled claim 7.

Regarding the prior art rejections, the Examiner respectfully maintains that the prior art teaches and/or suggests the invention as claimed as described in detail in the prior art rejections above and as argued in the previous Office action.

Thus, it is respectfully submitted that applicant's arguments cannot be considered to be persuasive and that the claims rejected over prior art cannot be considered to be allowable over the prior art of record.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
March 29, 2009